

**REMARKS**

Claims 1-25 are pending in the application.

Claims 14 and 20-25 were previously withdrawn from consideration, and have been canceled, without prejudice.

Claims 1-13 and 15-19 have been rejected.

Claims 1, 13, 15 and 16 have been amended, as set forth herein.

I. **REJECTION UNDER 35 U.S.C. § 102**

Claims 1-3, 7-13 and 15-19 were rejected under 35 U.S.C. § 102(b) as being anticipated by Grimes (“*Grimes*”) (US 5,479,482). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Regarding independent Claims 1, 13, 15 and 16, as amended, these claims recite a method, system and computer readable medium wherein a location sharing request is received after connection of a call and during pendency of the call between a first communications device and a second communications device telephone. Applicant respectfully submits that *Grimes*

does not describe a method, system or computer readable medium as recited in independent Claims 1, 13, 15 and 16.

The *Grimes* reference describes a cellular terminal for transmitting global satellite positioning (GPS) information defining its location during a 9-1-1 call. *Grimes, Abstract*. A cellular switching system or public safety answering point system may translate the GPS information into location information. *Grimes, Abstract*. In addition, the *Grimes* reference recites (Col. 4, line 56 through Col. 6, line 15) the following:

A local central office 111 which receives a "911" call from telephone 110 automatically connects the call over a trunk 116 to tandem central office 113 and forwards to office 113 the calling telephone number. Based on the received telephone number, office 113 connects the call over trunk 116 to one of the PSAPs and forwards to that PSAP the calling telephone number.

Office 113 also connects non-911 calls destined for PSAPs to the appropriate PSAPs over trunks 116. For any PSAP, however, the non-911 calls are connected over trunks 116 which are different from trunks 116 over which the 911 calls are connected.

Assuming that the call comes to PSAP 117 it is received by controller 121. If it is a non-911 call, it is connected by controller 121 to call-destination one of the community of users 135, in a conventional manner. If it is a 911 call and includes the calling telephone number, it is stored in first-in, first-out conventional queue 122 to await the freeing of an agent at one of the positions 127-128 to receive the call. The presences of the calling telephone number or geo-coordinates determines the type of 911 call. In the present example, the calling telephone number of the call is captured and is stored in memory along with other information about the call by controller 121. Calls are retrieved from queue 122 and distributed to positions 127-128 by controller 121. When controller 121 assigns a call to a position 127-128, controller 121 also formulates and sends a message to multiplexer 126 requesting information on the calling number be obtained from ALI computer 119 and transmitted to the assigned position by multiplexer 126. The calling number of the call and the identification of the position 127-128 to which the call has been assigned are provided by controller 121 in the message.

\* \* \*

In response to receipt of a message requesting the information associated with a telephone number, ALI computer 119 retrieves the information from database 120, formats it into a response message, and sends the response message to ALI node processor 114. Processor 114 in turn sends the response to the appropriate PSAP--the PSAP 117 in this example--where it is received by multiplexer 126 and forwarded to the agent position 127-128 that has been assigned to handle the call. When the agent at the position 127-128 answers the call, the data associated with the call's originating number are displayed on the position's DMU 132.

\* \* \*

Multiplexer 126 is connected via link 125 to GPS computer 124. Multiplexer 126 forwards the message to GPS computer 124, and GPS computer 124 accesses an internal database and converts the geo-coordinates to location information. This location information is then transmitted by GPS computer 124 to the agent position 127-128 that has been assigned to handle the cellular call. When the agent at the assigned position answers the cellular call, the municipal location information is displayed on that position's DMU. Controller 121 had previously alerted the assigned agent to the incoming 911 cellular call.

In the cited passage, *Grimes* recites that these activities occur *prior to* a connection between the first communications device and the second communications device. In contrast, Applicant's claims recite receiving a location information sharing request after connecting a call and during the pendency of the call between the first communications device and the second communications device. Therefore, *Grimes* fails to disclose each and every element of Applicant's independent Claims 1, 13, 15 and 16.

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(b) rejection of Claims 1-3, 7-13 and 15-19.

II. REJECTION UNDER 35 U.S.C. § 103

Claims 4-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Grimes (“Grimes”) (US 5,479,482) in view of Norris et al. (“Norris”) (US 5,805,587). The rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of

obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

As described above, *Grimes* fails to disclose receiving a location information sharing request after a connection of a call and during pendency of the call between the first device and the second device. Since Claims 4-6 are directly or indirectly dependent upon Claim 1, for at least the reasons recited above with respect to Claim 1, the Office Action fails to establish a *prima facie* case of obviousness against Claims 4-6.

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection of Claims 4-6.

### III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

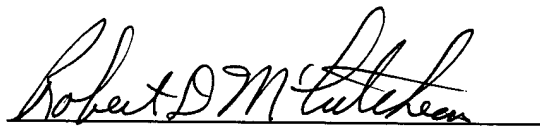
The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date:

8/26/2004

A handwritten signature in cursive script, reading "Robert D. McCutcheon", written over a horizontal line.

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